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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* PETER R. BROWNELL
9

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11 Appeal 2007-2931
12 Application 10/752,879
13 Technology Center 3600
14

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16 Decided: April 18, 2008
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19 Before TERRY J. OWENS, HUBERT C. LORIN, and
20 ANTON W. FETTING, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22
23 DECISION ON APPEAL

24 STATEMENT OF CASE

25 Peter R. Brownell (Appellant) seeks review under 35 U.S.C. § 134 of
26 a final rejection of claims 1-21, the only claims pending in the application on
27 appeal.

1 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
2 (2002).

3 We REVERSE.

4 The Appellant invented a way for on-line ordering of component
5 parts, and in particular to the on-line ordering of component parts for guns
6 from a supplier (Specification 1:5-6). It provides for selling replacement
7 parts for products over a computer network. A customer can identify and
8 order replacement parts for a product such as a gun or other firearm product.
9 The on-line ordering provides product manufacturer selection options for
10 customers to select from and part selections for the customer to select from.
11 It also provides an interactive schematic illustrating component parts of the
12 product with associated reference identifiers for selecting the component
13 parts. It also provides descriptions of component parts selected, including a
14 name and part number for the component part (Specification 2:12-23).

15 An understanding of the invention can be derived from a reading of
16 exemplary claim 1, which is reproduced below [bracketed matter and some
17 paragraphing added].

18 1. A method of selling replacement parts for a product to a
19 customer and over a computer network, comprising:
20 [1] providing a plurality of product manufacturer selection
21 options for the customer to select from over the computer
22 network;
23 [2] receiving a manufacturer selection of one of the product
24 manufacturers from the customer and over the computer
25 network;
26 [3] providing a plurality of product selections for the customer
27 to select from over the computer network;

[4] receiving a product selection of one of the products from the customer and over the computer network;

[5] providing over the computer network and to the customer an interactive schematic

illustrating a plurality of component parts of the product with associated reference identifiers;

[6] receiving a selection from the interactive schematic of at least one of the component parts over the computer network.

This appeal arises from the Examiner's Final Rejection, mailed February 14, 2006. The Appellant filed an Appeal Brief in support of the appeal on September 12, 2006. An Examiner's Answer to the Appeal Brief was mailed on December 7, 2006. A Reply Brief was filed on February 7, 2007.

PRIOR ART

The Examiner relies upon the following prior art: Uemura
US 2001/0027429 A1 Oct. 4, 2001

REJECTION

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Uemura.

ISSUES

The issue pertinent to this appeal is whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1-21 under 35 U.S.C. § 103(a) as unpatentable over Uemura. The pertinent

issue turns on whether it would have been obvious to add steps [1] to [4] to Uemura.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Uemura

01. Uemura is directed to a system for ordering parts of an analyzing system. Uemura's system stores part numbers data of the analyzing system and is capable of ordering a part corresponding to a part number by transmitting the part number to a supplier (Uemura: ¶ 0012).

02. Uemura's analyzer has a computer as part of it (Uemura: ¶ 0032; Fig. 1). This computer stores an equipment managing program for that analyzer, which includes a database of parts used by the analyzer, including part numbers (Uemura: ¶ 0041; Fig. 4).

03. Uemura also describes an interactive schematic, which Uemura refers to as a specifying diagram (Uemura: ¶ 0042; Fig. 5). Uemura does not explicitly describe where this schematic is stored, but implies it is stored in the same location as the parts data.

04. Uemura's parts suppliers provide a user identification number unique to each analyzer (Uemura: ¶ 0038).

Facts Related To Differences Between The Claimed Subject Matter And The Prior Art

05. Uemura does not describe or suggest steps [1]-[4] of claim 1.

Facts Related To The Level Of Skill In The Art

06. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent art of online ordering. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

07. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the

specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[1] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex*

1 *Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to
2 known methods is likely to be obvious when it does no more than yield
3 predictable results.” *KSR*, at 1739.

4 “When a work is available in one field of endeavor, design incentives
5 and other market forces can prompt variations of it, either in the same field
6 or in a different one. If a person of ordinary skill in the art can implement a
7 predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

8 “For the same reason, if a technique has been used to improve one
9 device, and a person of ordinary skill in the art would recognize that it would
10 improve similar devices in the same way, using the technique is obvious
11 unless its actual application is beyond his or her skill.” *Id.*

12 “Under the correct analysis, any need or problem known in the field
13 of endeavor at the time of invention and addressed by the patent can provide
14 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

15 ANALYSIS

16 *Claims 1-21 rejected under 35 U.S.C. § 103(a) as unpatentable over*
17 *Uemura.*

18 The Examiner found that Uemura described steps [5] and [6] of claim
19 1. The Examiner further found that one of ordinary skill would have known
20 that steps [1]-[4] would have allowed a customer to order parts for more than
21 one product. The Examiner concluded that it would have been obvious to a
22 person of ordinary skill in the art to have added steps [1] to [4] to Uemura
23 since it is well settled that it is obvious that mere duplication of essential

1 working parts involves only routine skill, citing *In re Harza*, 274 F.2d 669
2 (CCPA 1960) (Answer 4).

3 The Appellant contends that adding multiple manufacturers is not
4 mere duplication of parts (Br. 5:¶ 2) and that Uemura's schematic is not
5 provided over a network (Br. 4:¶ 1).

6 We agree. This is not a case as in *Harza* of duplicating a component
7 found in the art, as with plural ribs for stopping water from a reference
8 describing a single rib in *Harza*, *id* at 672. This is a case where the
9 limitation proposed by the Examiner is neither in the art nor suggested by or
10 even desirable with respect to the particular art applied (FF 05).

11 As the Appellant argues, Uemura simply has no need for
12 manufacturer and product selections, for the simple reason that Uemura's
13 product ordering system is designed for a single product whose
14 manufacturer and product are already established as the environment within
15 which Uemura's system operates. While the simple question "who am I"
16 makes for interesting philosophical inquiries, there is no reason that
17 Uemura's system would ever ask such a question, which would be the only
18 reason for adding steps [1]-[4] to what is described by Uemura. There is not
19 even a need for determining the manufacturer and model when ordering
20 parts because every analyzer is uniquely pre-identified by a user identifier
21 that is used to communicate with suppliers (FF 04).

22 Uemura is directed to an analyzer that includes a system for ordering
23 parts used by that analyzer (FF 01 & 02). The exact list of parts with part
24 numbers needed for Uemura's analyzer is stored within Uemura's analyzer,
25 itself. Thus, when ordering parts in Uemura, there is no need to first

1 determine a manufacturer and product to find a parts list or an interactive
2 schematic, as in steps [1]-[4]. Uemura implies that its interactive schematic
3 is internally stored, along with the parts data (FF 03). Thus, there would be
4 no need for supplying the schematic from a network as in claim 1. Thus, the
5 Examiner has chosen to apply a reference which clearly and particularly
6 negates the need for the modifications proposed by the Examiner. For this
7 reason, we must conclude the Examiner has failed to make a prima facie
8 showing of obviousness.

9 The remaining independent claims contain steps similar to steps [1]-
10 [4] in claim 1, and the dependent claims contain these steps by virtue of
11 incorporating the subject matter of the independent claims. Since these
12 issues are dispositive for all claims, the remaining arguments by the
13 Appellant are moot.

14 The Appellant has sustained its burden of showing that the Examiner
15 erred in rejecting claims 1-21 under 35 U.S.C. § 103(a) as unpatentable over
16 Uemura.

17 CONCLUSIONS OF LAW

18 The Appellant has sustained its burden of showing that the Examiner
19 erred in rejecting claims 1-21 under 35 U.S.C. § 103(a) as unpatentable over
20 the prior art.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-21 under 35 U.S.C. § 103(a) as unpatentable over Uemura is not sustained.

REVERSED

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